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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,395	02/03/2005	Kenji Arai	265470US0PCT	4134
22850 7590 05/30/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BOYER, CHARLES I	
			ART UNIT 1751	PAPER NUMBER
			NOTIFICATION DATE 05/30/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/523,395

Applicant(s)

ARAI, KENJI

Examiner

Charles I. Boyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This action is responsive to applicants' amendment and response received February 27, 2007. Claims 1-20 are currently pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The rejection of claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Horiuchi et al, US 4,486,334 is withdrawn in view of applicants' amendment and response.

3. Claims 1-20 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyajima et al, US 6,417,146.

Miyajima et al teach a pearlescent shampoo comprising a surfactant and an ethylene glycol distearate pearlescent agent wherein the composition is first heated to 80°C, and cooled with stirring (col. 5, examples 1-3). Though ethylene glycol distearate is the only pearlescent used in the examples, it is well known that a pure stearate fatty acid is in fact rare and would be prohibitively expensive to isolate 100% from the fatty acid source, which is always a mixture of fatty acids. It is well known to those of

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ordinary skill in the art that even when a stearate is referred to, it is understood that at least some fatty acids of different chain length will be present in the stearate.

Therefore, the examiner maintains that even trace amounts of fatty acids with chain lengths less than 18, very common in fatty acid mixtures, will satisfy the "less than 70%" fatty acids presently claimed.

In the alternative, if the reference is not anticipatory, though ethylene glycol distearate is the most preferred pearlescent of the reference, ethylene glycol monopalmitate is also taught as a suitable pearlescent of the invention (col. 3, lines 8-18). Accordingly, it would have been obvious to one of ordinary skill in the art to include at least a small amount of ethylene glycol monopalmitate in the examples with a reasonable expectation of successfully obtaining a pearlescent shampoo.

Applicants have traversed this rejection on the grounds that the reference there is no disclosure or suggestion of a molten ingredient (B). Moreover, such a process would not result in a pearlescence having the same structure as one prepared by depositing molten ingredient (B) on a surface of a suspension of ingredient (A). The examiner disagrees and notes that the heating of the ethylene glycol distearate to 80°C with stirring will result in a molten distearate and the mixing process will result in at least some deposition.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by Chen et al, US 6,165,955.

Chen et al teach a pearlescent shampoo comprising a surfactant and an ethylene glycol distearate pearlescent agent wherein the mixed with water, heated to 80°C, and cooled with stirring (col. 14, example 1 and col. 7, lines 23-31). Note that the ethylene glycol distearate is at a minimum 90% stearate fatty acid (col. 14, lines 36-40) but is not higher than 99% stearate (col. 16, claim 4). Accordingly, at least some of the stearate is fatty acids of different chain lengths than C18. Therefore, the examiner maintains that even trace amounts of fatty acids with chain lengths less than 18, very common in fatty acid mixtures, will satisfy the "less than 70%" fatty acids presently claimed. The preferred pH of these compositions is as low as 4 (col. 7, lines 18-22).

5. Claims 3, 4, 14-19, and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Decoster, US 6,294,160.

Decoster teaches a pearlescent shampoo comprising a surfactant and a mixture of ethylene glycol distearate and ethylene glycol dipalmitate present in a ratio of 70:30 (col. 6, example). These compositions have a pH as low as 3 (col. 7, claim 18). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Applicants have traversed this rejection on the grounds that the reference does not include a teaching wherein ingredient (B) is deposited on a surface of a suspension ingredient (A). Though this is true, this is a product by process limitation, and where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon applicant to come forward

with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiuchi et al, US 4,486,334 in view of Decoster, US 6,294,160.

Horiuchi et al teach a method for making a pearlescent composition suitable for use in shampoos wherein a surfactant and a mixture of ethylene glycol stearate and ethylene glycol palmitate is first heated to 80°C, resulting in a molten stearate/palmitate mixture, mixed, and then cooled (col. 5, example 1). The examiner maintains that this heating and cooling process with mixing will inherently result in the deposition claimed, that is, at least some of the stearate will be deposited on the palmitate in the normal course of mixing. The reference, however, teaches 40% palmitate and 60% stearate.

Recall that Decoster teaches a pearlescent shampoo comprising a surfactant and a mixture of ethylene glycol distearate and ethylene glycol dipalmitate present in a ratio of 70:30. This mixture of ethylene glycol distearate and ethylene glycol dipalmitate is a commercially available pearlescent. As this pearlescent is particularly preferred for

use in shampoos, it would have been obvious to one of ordinary skill in the art to use a well-known, commercially available pearlescent in the method of Horiuchi et al with a reasonable expectation of successfully obtaining a pearlescent shampoo.

Applicants have traversed the rejection of Horiuchi et al when it was applied as a 102 reference on the grounds that there is no disclose or suggestion of a molten ingredient (B). Moreover, such a process would not result in a pearlescence having the same structure as one prepared by depositing molten ingredient (B) on a surface of a suspension of ingredient (A). The examiner disagrees and notes that the heating of the mixture of ethylene glycol stearate and ethylene glycol palmitate to 80°C will result in a molten stearate/palmitate, and the mixing process will result in at least some deposition.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571 272 1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Charles I Boyer
Primary Examiner
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